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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/559,778

**Applicant(s)**

LIGHT ET AL.

**Examiner**

James H. Zurita

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 80-86,89-98,101-110 and 113-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-86,89-98,101-110 and 113-115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/05/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Prosecution History***

On 27 April 2000, Applicant filed the present application as a continuation in part of 09/167873, filed 7 October 1998, now US patent 6,092,053, issued on 18 July 2000.

On 18 June 2003, the Examiner rejected claims 1-79 as unpatentable over Peckover, WO 97/26612-A1, international publication date of 24 July 1997, in view of an article by Robert Greene, "Online College Applications, Pushing Out Paper", Sep 1, 1997, St. Louis Post - Dispatch; St. Louis, Mo.

On 3 September 2003, Applicant cancelled claims 1-79, adding claims 80-115.

On 19 November 2003, in a Final rejection, the Examiner rejected claims 80-119 as unpatentable over Peckover (6,119,101) in view of *Walker* (5794207).

On 5 August 2004, Applicant filed a first Request for Continuing Examination (RCE). The accompanying amendment, while non-compliant, appeared to be a bona-fide attempt to respond. The Examiner provided applicant with a one-month period to respond. Applicant's response of 20 August 2004 included a complete listing of all claims.

On 20 November 2004, the Examiner rejected claims 80-115 as unpatentable over Peckover in view of Walker, above.

On 27 January 2005, applicant filed a second request for reconsideration (RCE)

On 12 April 2005, the Examiner rejected claims 80-115 as being unpatentable over Peckover in view of Walker, above.

This Office Action responds to applicant's amendment of 21 July 2005.

***Response to Amendment***

On 21 July 2005, applicant cancelled claims 87-88, 99-100, 112-112, amended claims 80, 92, 93, 96-98 and 101-105.

Claims 80-86, 89-98, 101-110, 113-115 are pending and will be examined.

***Priority***

Applicant's traverse of the Examiner's request to clarify the record is not persuasive and is non-responsive. Applicant argues, in part,

It is respectfully asserted that the Examiner has improperly asserted that the present application is entitled to only the filing date of the present application. As indicated in MPEP 201.09, unless the filing date of an earlier application is actually needed to overcome a reference, there is no need for the office to make a determination as to whether the earlier application discloses the invention in a continuation-in-part situation. The MPEP indicates that an alleged continuation-in-part application should be allowed to claim the benefit of the earlier application if there is a common inventor, the applications were co-pending and the continuation-in-part application contains a reference to the earlier filed application. These requirements have been met, and the Peckover and Walker references asserted against the claims do not have effective dates that raise an issue as to whether the filing date of the parent application is needed...

Moreover, as indicated in the MPEP, the present situation does not make such a determination necessary.

At the onset, the Examiner notes that the section cited by applicant, MPEP 201.09, Substitute Application, fails to support applicant's assertions.

The Examiner agrees that applicant is allowed to claim the benefit of the earlier application; that there is at least one common inventor; that the applications were copending, and that the continuation-in-part contains a reference to the earlier filed application. These facts are not at issue.

At issue is the fact that Applicant has claimed priority for the present application as being a Continuation-in-Part to prior application(s) that cover(s) a wide range of subject matter and have little, if any, pertinence to the present application. The Examiner once again requests the Applicant identify where in the prior application(s) the features of the present invention are first disclosed. Since the prior application(s) also list(s) different inventors than the present application (but with at least one common inventor), the examiner also requests the Applicant identify which inventor(s) contributed which features claimed in the present application that were also present in one or more prior application with different inventors.

**Applicant also argues**

...further, even if the references were intervening references, before concluding claims of the present application are not entitled to the filing date of the parent application, the Examiner would have to make a finding that the claims of the application are not supported by the specification of the parent application.

...Applicants have not made an analysis of this issue, and do not intend on doing so unless an intervening reference showing the claimed invention is applied, and the Examiner asserts on the record that certain claimed features are not present. It is asserted that it is improper for the Examiner to require Applicants to point out support in the parent application for certain claimed features when there is no intervening reference being applied, and applicants request that the Examiner withdraw the unsupported statement that the claims are only entitled to the April 27, 2000 filing date.

As previously noted, claims directed to **data subject** and **data recipient** are accorded the filing date of the instant application, 27 April 2000, because 09/167873 does not appear to support [emphasis added]:

80. A method for pub allowing a **data subject** to purchase an item from a **data recipient** over a computer network, comprising:
- (a) receiving, from a **data subject** network communication device, an offer associated with a the **data recipient** and a message including a network communication device software identifier, the offer and the message being received at a data repository computer;
  - (b) determining whether the **data subject** is registered;
  - (c) determining whether the **data recipient** is authorized;

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- (d) if the **data subject** is registered and the **data recipient** is authorized, retrieving purchasing information associated with the **data subject** from a database in the data repository computer;
- (e) sending a purchase query to the **data subject** network communication device; and
- (f) in response to a purchase reply received from the **data subject** network communication device, sending purchase transaction information to the **data recipient**.

Again, the Examiner acknowledges applicant's claim to priority to Application 09/167873, filed **7 October 1998**, issued on 18 July 2000 as US Patent 6,092,053.

The Examiner also notes

- applicant's refusal to point out where the material appears in 09/167873.
- applicant's decision to not refute the Examiner's observation that certain material is absent from 09/167873.

An additional search reveals that inventors, Light and Ersheid also appear as co-inventors in application **09/572795, filed 17 May 2000**.

Light, in turn, is one of four inventors listed in various combinations in 09/167873 and in related applications and patents:

Inventor Name	City	State/Country
Boesch, Brian	Oak Hill	Virginia
Farrell, Patrick	Falls Church	Virginia
Light, Elliott	Rockville	Maryland
Eisenberg, R Scott	Bethesda	Maryland

### ***Double Patenting***

The Examiner acknowledges the terminal disclaimer filed over 6,092,053, issued 20 July 2000 from application 09/167873, filed 7 October 1998.

Claims 80, 92 and 104 and claims dependent thereupon are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-57 of copending Application No. 09/572795, filed 17

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May 2000. Although the conflicting claims are not identical, they are not patentably distinct from each other. Application 09/572795's claims are directed to purchasing an item or service over a network using a stored value instrument comprising:

- Receiving a purchase offer, including a data subject identifier, a data recipient identifier and a price, from a data subject;
- Determining at least one stored value instrument accepted by a data recipient;
- Sending a list of accepted stored value instruments to the data subject
- Receiving a selection of at least one stored value instrument from the list of accepted stored value instruments from the data subject; and
- Sending the purchase offer and the selected stored value instrument to the data recipient.

The Examiner takes official notice that it is old and well know to provide customers with a list of acceptable forms of payment, including a list of accepted credit cards, debit cards, for example.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine 09/572795 with general knowledge to disclose,

80. A method for pub allowing a data subject to purchase an item from a data recipient over a computer network, comprising:
- (a) receiving, from a data subject network communication device, an offer associated with a the data recipient and a message including a network communication device software identifier, the offer and the message being received at a data repository computer;
  - (b) determining whether the data subject is registered;
  - (c) determining whether the data recipient is authorized;
  - (d) if the data subject is registered and the data recipient is authorized, retrieving purchasing information associated with the data subject from a database in the data repository computer;
  - (e) sending a purchase query to the data subject network communication device; and
  - (f) in response to a purchase reply received from the data subject network communication device, sending purchase transaction information to the data recipient.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine 09/572795 with general knowledge to disclose

80. A method for pub allowing a data subject to purchase an item from a data recipient over a computer network, comprising:
- (a) receiving, from a data subject network communication device, an offer associated with a the data recipient and a message including a network communication

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device software identifier, the offer and the message being received at a data repository computer;

- (b) determining whether the data subject is registered;
- (c) determining whether the data recipient is authorized;
- (d) if the data subject is registered and the data recipient is authorized, retrieving purchasing information associated with the data subject from a database in the data repository computer;
- (e) sending a purchase query to the data subject network communication device; and
- (f) in response to a purchase reply received from the data subject network communication device, sending purchase transaction information to the data recipient.

For the obvious reason that different customers may carry different types of payment instruments and may wish to charge items to different cards, for example.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 80, 92, 104** and claims dependent thereupon are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to "...receiving, from a data subject, an **offer** associated with a merchant..."

The Examiner respectfully notes that (a) applicant's use of the term **offer** varies from its ordinary meaning and (b) applicant's new definition is different from the term's original definition in the specifications.

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**As to (a)**, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The term "offer" in claims 80-115 is used by the claim to mean

...The authorized data recipients Web site invites the data subject to send a set of data subject information to the authorized data recipient thereby consummating a transaction (an "**offer**"). [specifications, page 5, lines 7-9, emphasis added]

The accepted meaning is "(n) a presenting of something for acceptance...a price named by one proposing to buy"<sup>1</sup>

**As to (b)**, applicant's new definition is different from the above.

The **offer** as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party).

Applicant's comments are misleading since the specifications clearly associate an offer as originating from a data recipient, not from a data subject:

The authorized data recipient's Web site also operates client software. When the data subject accepts the authorized **data recipient's offer** to consummate a transaction, the client software sends both e. a file readable by the NCD software and the authorized **data recipient's offer** to the NCD software that is resident on the data subject's NCD. The NCD software readable file includes information to identify the authorized data recipient, an address for the authorized data recipient's Web page and instructions that instruct the NCD software to communicate with the CIS software. The authorized **data recipient's offer** passes through the data subject's NCD to the CIS software resident on the data repository. [specifications, page 5, lines 10-17, emphasis added]

Further, in response to applicant's comments concerning the elements required by his claims to an **offer**, it has been found "That a person skilled in the art might realize

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<sup>1</sup> Definition of *offer*, MERRIAM WEBSTER'S Collegiate Dictionary.

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from reading the disclosure that such a particular definition (as now argued) is a possible definition is not a sufficient indication to that person that that particular definition is part of Applicant's invention as originally filed. Claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application. In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). In the instant case, Applicant has not persuasively demonstrated that the Examiner has applied an unreasonable interpretation of the recited feature, or that the interpretation is inconsistent with the specification, or that applied interpretation is repugnant to one of ordinary skill in the art. The Examiner will continue to give the term **offer** its broadest reasonable interpretation as noted above.

Since the term **offer** is indefinite, yet includes the concept of "...send[-ing] a set of [customer] information ... consummating a [...purchase...] transaction, the term ***purchase transaction information*** is likewise rendered indefinite.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80-86, 89-98, 101-110, 113-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peckover (6,119,101) in view of *Walker* (5,794,207).

As noted previously, without traverse,

- **data repository** will be given its broadest reasonable interpretation to mean a collection of information about a computing system such as a database and database management software (data repository software). Peckover discloses the use of collections of

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information about his computing systems.<sup>2</sup> See, for example, references to databases and collections of information concerning object server, agent system, agent managers and others, Figs. 1-10 and related text.

- **descriptive material** (for example, "data subject", "data recipient", "network communication device") does not distinguish the claimed invention from the prior art in terms of patentability. For purposes of applying prior art the term "data subject" will be interpreted to read on patrons, buyers, clients, shoppers, purchasers, users, consumers, consumers, a party to a transaction, etc. The term "data recipient" will be interpreted to read on merchants, sellers, providers, users, a party to a transaction, etc.
- **network communication device** will be interpreted to read on any type of device that might be used to connect a client node to a network in a client/server network architecture. The types of clients may include personal computers, workstations, telephones, dumb and intelligent programmable devices, wireless devices, PDA's. Users on client machines may use a client to search in or access server databases, select, search, request searches, download files and information, and generally interact with one or more servers on a network. Peckover, Fig. 22, item 22.
- **network communication device software identifier** will be interpreted to read on any client-side software (e.g., an Internet browser) that identifies a client node to a server, such as a cookie (e.g., specifications, page 7, lines 7-13).
- **To purchase** is to **obtain** by paying money or its equivalent.<sup>3</sup> Peckover discloses that merchants **obtain** a customer's review of an advertisement (merchant offer) **by paying** money or equivalent credits, as in Col. 37, line 66- Col. 38, line 5.
- **purchase transaction information** will be given its broadest reasonable interpretation to include data sufficient to complete a transaction, as in applicant's Fig. 2B, item 224.

**As per claim 80**, Peckover discloses method for allowing customers (applicant's data subjects) to purchase an item from a merchant (applicant's data recipient) over a computer network. Peckover discloses:

Customers receive advertisements (applicant's offer associated with a data recipient) at PC's (applicant's network communication device), as in Fig. 2, item 22.

Customers review, and accept or decline the offers, using web browser software (applicant's network communications software). The message is transmitted to the server, which receives the information from customers. Thus, Peckover discloses

(a) **receiving**, from a customer's PC (data subject network communication device)

<sup>2</sup> Definition of Repository, MICROSOFT Computer Dictionary.

<sup>3</sup> Definition of purchase (v.), MERRIAM WEBSTER'S Collegiate Dictionary.

- (a.1) an offer associated with a merchant [the offer/advertisement is associated with a merchant in that the offer was (i) created by a merchant and (ii) contains information entered by a merchant, as in Fig. 42, for example. **and**
- (a.2) a message (in that a customer reviews, accepts or rejects the offer), including a cookie (network communication device software identifier). See, for example, at least Figs. 40-42 and related text. For cookie, see at least Col. 6, lines 26-32. See also discussion of persistence in previous office actions.
- (a.3, **new**) the offer and the message being received at a data repository computer. See definition of data repository, references to Peckover, which interpretation was previously asserted by the Examiner. This and other claim interpretations have not been traversed and are therefore admitted prior art.
- (b) **determining** whether the customer is registered. See, for example, at least Fig. 39 and related text, including Col. 15, line 64-Col. 16, line 24. Please also note that only registered customers may access the various functions.
- (c) **determining** whether the merchant is authorized. See, for example, at least Fig. 39 and related text, including Col. 15, line 64-Col. 16, line 24. Please also note that only authorized merchants may access the various functions.
- (d) **retrieving** information associated with the customer from a database, in the data repository computer. See, for example, at least Col 18, line 31-Col. 19, line 44, which refer to customer preference data [i.e., information associated with a customer ; the data is marinated in the database]. See also references to personal agents, which contain information associated with a customer's needs. See also discussion of

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consumer consideration accounts, i.e, information associated with a customer, such as credits. The examiner notes that this information is retrieved only if a customer is registered and a merchant is authorized [to access it].

(e) **sending a query** to the customer's network communication device. See, for example, references to collecting and delivering matching search results to customers, as in Col. 29, line 41-Col. 30, line 63. The results may include advertisements that satisfy a customer's search.

(f) **sending** transaction information to the merchant [in response to a **reply** received from the customer PC network communication device]. See, for example, references to sending transaction information to merchants, including information such as amounts that a customer finds acceptable in exchange for viewing advertisements, as in Col. 37, line 66-Col. 38, line 15. See also references to logging, as discussed in previous office actions.

Peckover **does not** use the terms purchase query, purchase reply, purchase transaction information. Peckover also provides examples of applying his invention to purchases of products and goods. Col. 10, lines 5-58, Col. 27, line 50-65. Walker discloses buying and selling items over the Internet, checking credit card information by merchants. See, for example, at least Fig. 6 and related text.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover and Walker to buy/sell items over a network, and exchange information related to purchase transactions of items. One of ordinary skill in the art at the time the invention was made would have been motivated to

combine Peckover, Walker and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose buying/selling items over a network, and exchange information related to purchase transactions of items for the obvious reason that a viable marketplace must involve the exchange of market information as well as the more obvious trading for goods and services.

Peckover and Walker **do not** use the terms data subject and data recipient. However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this various labels will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Merely labeling the entities and data differently from that in the prior art would have been obvious.

**As per claim 81**, Peckover discloses the use of cookies. See, for example, Col. 6, lines 26-32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover and knowledge generally available to disclose that determining whether the customer is registered may include determining whether a cookie matches an entry in the database. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Peckover and knowledge generally available to disclose that determining whether the customer is registered may include determining whether a cookie matches an entry in the database for the obvious reason that the main purpose of cookies is to identify users and possibly

prepare customized web pages for them by checking the contents of a cookie with database entries.

**As per claim 82**, Peckover discloses that an offer may include a merchant identifier(s) (such as brand, model, location, vehicle make, model, dealer) an item price, a final price indicator and a transaction number. See, for example, at least Fig. 40, 41 and related text, which show various types of information that may be provided by merchants when they create an offer. Peckover discloses the needs of security, privacy and confidence or trust for an electronic marketplace.

Peckover and Walker **do not** use the term "transaction number" Peckover and Walker disclose tacking various types of transactions and storing associated information. It would have been obvious to track transactions with the use of transactions number, and to extend Perckover and Walker to include transaction numbers, including transaction numbers for purchases in Walker.

One of ordinary skill in the art would have been motivated to track transactions with the use of transactions number, and to extend Perckover and Walker to include transaction numbers, including transaction numbers for purchases in Walker for the obvious reason that databases often have keys/indices and having transaction numbers may be helpful in accessing the data for analysis.

Peckover **does not** specifically disclose the use of a digital signature. Walker discloses the use of digital signatures, as in Col. 23, line 64-Col. 24, line 24.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover, Walker knowledge generally available to one

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of ordinary skill to disclose the use of digital signatures. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Peckover, Walker and knowledge generally available to one of ordinary skill to disclose the use of digital signatures for the obvious reason that a viable marketplace must also address side-effects of commerce such as issues of security, privacy and confidence or trust, since otherwise, consumers and providers will not feel comfortable enough to participate in the marketplace.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type of information because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

**As per claim 83**, Peckover **does not** specifically disclose that shipping information may also include a preferred shipping method. Peckover discloses that when customer orders or purchases a product, a customer may need to reveal delivery address, credit card data. See, for example, at least Col. 6, lines 32-42. Peckover

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discloses advantages and disadvantages of various delivery and shipping methods, including third class mail, special mailing classes, as in Col. 3, line 53-Col. 4, line 13.

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Peckover a preferred shipping method.

One of ordinary skill in the art at the time the invention was made would have been motivated to include in Peckover a preferred shipping method for the obvious reason that thus be able to receive timely delivery of their products, for example, by requesting special delivery over third class mail.

**As per claim 84**, Peckover **does not** specifically disclose determining whether credit card information is accepted by a merchant. However, it is well known that credit card information is often verified and accepted by a merchant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Peckover knowledge generally available to one of ordinary skill in the art to disclose determining whether credit card information is accepted by a merchant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Peckover knowledge generally available to one of ordinary skill in the art to disclose determining whether credit card information is accepted by a merchant, since some merchants accept only certain credit cards in exchange for purchases.

**As per claim 85**, Peckover and Walker **do not** specifically disclose obtaining a new price from the data recipient based on the shipping address and the preferred shipping method; and setting the item price equal to the new price.

However, Peckover discloses various forms of delivery of a product, including bulk mail, special mailing classes, third class mail, and other delivery methods.

Peckover discloses that special mailing classes may reduce mailing costs but may result in erratic delivery times. Peckover discloses providers who use third class mail cannot pinpoint even the week that the mail may be delivered. The Examiner takes official notice that delivery costs may vary according to (a) distance from a mailing point, and (b) whether an item is delivered via postal mail or via specialized services such as Federal Express. The Examiner also notes that it is well known to pass these costs by increasing total amount payable by a customer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover and knowledge generally available to one of ordinary skill in the art to disclose obtaining a new price from the data recipient based on the shipping address and the preferred shipping method; and setting the item price equal to the new price.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Peckover and knowledge generally available to one of ordinary skill in the art to disclose obtaining a new price from the data recipient based on the shipping address and the preferred shipping method; and setting the item price equal to the new price for the obvious reason that by passing costs on to a customer, a merchant is able to maintain his profits at a higher level than otherwise.

**As per claim 86** Peckover discloses prompting the customer for a passphrase and authenticating the customer based on a passphrase stored within the database. See, for example, at least Fig. 39 and related text.

**As per claim 89**, Peckover discloses storing the transaction information in an authorized merchant transaction log. See, for example, at least references to query logger and its functions, transaction history data and system history data, as in Col. 24, line 62-Col. 25, line 10. See also references to log functions.

**As per claim 90** Peckover discloses storing the transaction information in a customer transaction log. See, for example, at least references to query logger and its functions, transaction history data and system history data, as in Col. 24, line 62-Col. 25, line 10. See also references to log functions.

**As per claim 91** Peckover discloses matching customer queries with merchant offers and notifying customers of such matches. See, for example, at least Col. 37, line 66-Col. 38, line 12. These messages confirm acceptance or confirm refusal of transactions to both customers and merchants.

Claim 92 is rejected under the same line of reasoning as claim 80.

Claim 93 is rejected under the same line of reasoning as claim 81.

Claim 94 is rejected under the same line of reasoning as claim 82.

Claim 95 is rejected under the same line of reasoning as claim 83.

Claim 96 is rejected under the same line of reasoning as claim 84.

Claim 97 is rejected under the same line of reasoning as claim 85.

Claim 98 is rejected under the same line of reasoning as claim 86.

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Claim 101 is rejected under the same line of reasoning as claim 89.

Claim 102 is rejected under the same line of reasoning as claim 90.

Claim 103 is rejected under the same line of reasoning as claim 91.

Claim 104 is rejected under the same line of reasoning as claim 80.

Claim 105 is rejected under the same line of reasoning as claim 81.

Claim 106 is rejected under the same line of reasoning as claim 82.

Claim 107 is rejected under the same line of reasoning as claim 83.

Claim 108 is rejected under the same line of reasoning as claim 84.

Claim 109 is rejected under the same line of reasoning as claim 85.

Claim 110 is rejected under the same line of reasoning as claim 86.

Claim 113 is rejected under the same line of reasoning as claim 89.

Claim 114 is rejected under the same line of reasoning as claim 90.

Claim 115 is rejected under the same line of reasoning as claim 91.

### ***Response to Arguments***

Applicant's arguments filed 21 July 2005 have been fully and very carefully considered.

Rejection under 35 USC 101 is withdrawn in view of amendment.

Applicant's comments concerning Priority are not persuasive. See above.

Applicant's comments concerning rejection under 35 USC 112 are not persuasive. See above.

The Examiner notes that Applicant's prior responses contained numerous arguments concerning **offer**. Applicant now only argues that his definition of **offer** includes various limitations that are still not present in the prior art:

"The offer as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party)."

This is certainly not a definition of the recited term "offer" as asserted by the Examiner, but is instead merely pointing out that the other recitations around the term "offer" in claim 80 of "an offer associated with the data recipient and a message including a network communication device software identifier" require the offer to be (1) received from a data subject (amended to recite a data subject network communication device) and (2) associated with a data recipient (a second party), **require more than just any offer**. [emphasis added]

These arguments have been raised and answered. Nevertheless, the Examiner will expand on the issue of indefiniteness.

While applicant may be his or her own lexicographer, a term may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). While applicant's use of the term is not totally repugnant to the usual meaning of the term, applicant's use of the term is misleading and inconsistent with its meaning and usage. Applicant now asserts that his **offer** "...require[s] **more than just an offer**..." but does not clarify how much more, or what is "...more than a just an offer..." The elusiveness of applicant's definition and use of **offer** fails to overcome indefiniteness.

Applicant refers to his specification at several points:

Regarding the term "offer", the **specification** at page 12, for example, discusses items that may be included in an offer in the context of a computer transaction, as referenced in the office action. The Examiner's reference to a dictionary is inappropriate, as such a dictionary definition is general, and not in the context of a computer transaction. Further, the Federal Circuit sitting en banc in Edward H. Phillips v. AWH Corp., 03-1269, -1286 (Fed. Cir., July 2005) has cautioned against the improper use of dictionaries, and refers to the improper use of general dictionaries. The court emphasizes the importance of the **specification** in interpreting the claims.

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Further, the Examiner incorrectly refers to Applicants "new definition" being different from the terms definition in the **specification**, specifically referring to the Applicants statement that:

"The offer as claimed must be: (1) received from a data subject (a first party) and (2) associated with a data recipient (a second party)."

This is certainly not a definition of the recited term "offer" as asserted by the Examiner, but is instead merely pointing out that the other recitations around the term "offer" in claim 80 of "an offer associated with the data recipient and a message including a network communication device software identifier" require the offer to be (1) received from a data subject (amended to recite a data subject network communication device) and (2) associated with a data recipient (a second party), **require more than just any offer. [emphasis added]**

In response to this comment, see 35 USC 112 rejection, above. *In Re Prater*.

As previously noted without applicant traverse, Applicant has not persuasively demonstrated that the Examiner has applied an unreasonable interpretation of the recited feature, that the interpretation is inconsistent with the specification, or that applied interpretation is repugnant to one of ordinary skill in the art.

The Examiner notes that appellant provides no definitions for the various terms. Since appellant has provided no explicit definition for the above terms, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003).

Applicant's arguments concerning rejection under **35 USC 103(a)** over Peckover and Walker are not persuasive.

First, where the prior amendment relied on cites to the prior art, Applicant's latest amendment assiduously avoids citations to the prior art altogether. Thus, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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Applicant argues,

...Office Action asserts that Peckover discloses receiving from a customer an offer associated with a merchant. The Office Action does not assert where Peckover allegedly discloses this feature, and applicants request a specific citation. The Examiner is apparently asserting that in Peckover an offer is received from a consumer, where the offer was created by a merchant. Applicants do not believe that Peckover contains any such disclosure.

In response, applicant's attention is respectfully directed to the prior office action, page 14, for the Examiner's assertion. As previously noted, a merchant creates an offer by entering information concerning the offer, for example. The Examiner notes that Applicant does not argue otherwise, and that applicant's beliefs and mere pleadings do not constitute a proper traverse.

Applicant argues,

In Applicants claims,[...amended claims...] The Office Action asserts that in Peckover, the offer is associated with a merchant (because it was created by the merchant), and that this offer created by the merchant is received from a customer. Peckover does not appear to disclose such an offer created by a merchant is received from a customer. While a customer may review an offer, and even accept the offer, Applicants do not see a disclosure that the offer itself is then sent from the customer. Because Peckover is missing this feature, and because Walker does not remedy this deficiency, none of the pending claims are obvious over the cited references.

Applicant admits that prior art discloses that a customer may review an offer, and that a customer may accept an offer. The Examiner respectfully notes that when a customer accepts an offer, the offer and related information is sent from the customer to the merchant. In exchange, customers receive payment for example. See also Abstract, Col. 23, lines 24-30.

Again, the Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It

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is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Examiner notes that Applicant has dropped all other arguments and objections concerning prior art. Applicant appears to have been persuaded by the Examiner's additional explanations and cites. For example, applicant no longer argues:

[Peckover] does not disclose an offer that is ...(1) received from a data subject (a first party) and (2) associated with a data recipient (second party).

...prior art does not disclose or suggest "determining whether the data subject is registered...[Peckover] teaches away from determining whether a data subject is registered.

[Walker] does not disclose or suggest sending a purchase query to a buyer...

... that Peckover does not disclose the use of a cookie (applicant's network communications device software identifier) and that none of Peckover's databases are disclosed as determining whether a customer is registered.

...The cited references do not disclose or suggest an offer containing a data recipient identifier, an item price, a data recipient digital signature, a final price indicator, and a transaction number. ...Peckover includes no teachings related to actual purchase transactions, thus it would be irrelevant for Peckover to disclose an offer that contained a transaction number....

Finally, there is no mention of price negotiations or modifications in either Peckover or Walker, thus a final price indicator would have been meaningless within the references. Particularly in Walker, where an offer could be legally binding in its terms, it would destroy the function of the invention to allow the price to change after the offer was accepted. As all transaction processing is handled automatically and immediately by the central controller, changes in price would be impossible within Walker. (Walker, col. 19, 1. 13, though col. 20, 1. 30).

...the prior art does not disclose or suggest obtaining a new price from a data recipient based on a shipping address or preferred shipping method. As explained above, Peckover teaches against the disclosure of information regarding one user to a different user. ...In Walker, as well, this feature would destroy the purpose of that invention. Walker explicitly binds the users to a contract as soon as a seller accepts the buyer's offer. ... buyer's ad could specify a shipping address and preferred method, thus allowing the seller to set a price specific to that information, .... Additionally, in Walker the person responsible for any shipping is made aware of all of these factors within the offer. (emphasis added)

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Furthermore, buyer information is stored throughout the central database in Walker. Buyer's name and credit card information may be stored in at least four separate places: ...This would completely destroy the goal of anonymity and information protection in Peckover.

In addition to the above, the Examiner highlights that a "traverse" is a denial of an opposing party's allegations of fact.<sup>4</sup> The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of

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<sup>4</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

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applicant's failure to adequately traverse official notice, the following are also admitted

prior art:

- ...delivery costs may vary according to (a) distance from a mailing point, and (b) whether an item is delivered via postal mail or via specialized services such as Federal Express. The Examiner also notes that it is well known to pass these costs by increasing total amount payable by a customer.
- ...viable marketplace must involve the exchange of market information as well as the more obvious trading for goods and services.
- ...labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this various labels will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Merely labeling the entities and data differently from that in the prior art would have been obvious.
- ... the main purpose of cookies is to identify users and possibly prepare customized web pages for them by checking the contents of a cookie with database entries.
- ... databases often have keys/indices and having transaction numbers may be helpful in accessing the data for analysis.
- ... a viable marketplace must also address side-effects of commerce such as issues of security, privacy and confidence or trust, since otherwise, consumers and providers will not feel comfortable enough to participate in the marketplace.
- [...customers...] may be able to receive timely delivery of their products, for example, by requesting special delivery over third class mail.
- ... some merchants accept only certain credit cards in exchange for purchases.
- ...it is well known to pass these costs by increasing total amount payable by a customer.
- ... by passing costs on to a customer, a merchant is able to maintain his profits at a higher level than otherwise.
- ...it is well known that credit card information is often verified and accepted by a merchant.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
17 October 2005

JZ

  
**WYNN W. COGGINS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**